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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,491	01/09/2002	Hidehei Kageyama	No. 50	2851

7590 03/08/2004  
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EXAMINER

PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 03/08/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/040,491

Applicant(s)

KAGEYAMA ET AL.

Examiner

Kathleen J. Prunner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003 and 10 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,10,13-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,10,13-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed October 15, 2003 (Paper No. 8) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “the rib 50g can be elastically biased in the radial direction into contact with the inner surface of the barrel (tip end member)”, as the amendment to the specification directed to page 6, lines 12-22, in the second paragraph, on lines 3-4, now reads. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Request for Continued Examination***

2. The request filed on November 10, 2003 (Paper No. 11) for a Request for Continued Examination (RCE) under 37 CFR 1.114 (a)(3) based on parent Application No. 10/040,491 is acceptable and an RCE has been established. An action on the RCE follows.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed terminology. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claimed terminology which lacks such antecedent basis is as follows: (A) “single-piece lead holder”, as now called for by claims 1, 4, 6, 8 and 10; and (B) “single-piece writing medium holder”, as now called for by claims 13, 15, 16 and 21. Correction is required.

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 4-8, 10, 13-17, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “the rib 50g of the outside cylinder 50c forms a contact portion that comes into contact with the inner peripheral face of the tip end member 14” (note the paragraph beginning on line 22 of page 6) and for “on the outer peripheral face of the outside cylinder 50c, a rib 50g projecting in the outside diameter direction is formed, and a slit 50i is formed in a portion in which the rib 50g of the outside cylinder 50c is absent. Thus, the rib 50g can be displaced elastically in the radial direction” (note lines 17-21 on page 6 of the originally filed disclosure), does not reasonably provide enablement for “said contact portion(s) comprise(s) an outer peripheral surface that is elastically displaceable radially outwardly into contact with said inner peripheral face of the barrel”, as now called for by claims 1 and 10. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

6. Claims 4, 5, 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “the rib 50g of the outside cylinder 50c forms a contact portion that comes into contact with the inner peripheral face of the tip end member 14” (note the paragraph beginning on line 22 of page 6), does not reasonably provide enablement for “wherein said contact portion comprises an outside cylinder provided concentrically on an outside of the

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body”, as now called for by claims 4 and 13. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

7. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “the rib 50g of the outside cylinder 50c forms a contact portion that comes into contact with the inner peripheral face of the tip end member 14” (note the paragraph beginning on line 22 of page 6) and for “on the outer peripheral face of the outside cylinder 50c, a rib 50g projecting in the outside diameter direction is formed, and a slit 50i is formed in a portion in which the rib 50g of the outside cylinder 50c is absent. Thus, the rib 50g can be displaced elastically in the radial direction” (note lines 17-21 on page 6 of the originally filed disclosure), does not reasonably provide enablement for “a single-piece writing medium holder” that comprises “an outer peripheral surface that is elastically displaceable radially outwardly into contact with an inner peripheral face of the barrel”, as now called for by claim 21. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 10, 13-17, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 10 recites the limitation "said contact portions" in line 16. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1, 4-8, 10, 13-17 and 19-21 are rejected under 35 U.S.C. 102(b) 103(a) as being anticipated by unpatentable over Kanari et al. Kanari et al. disclose a mechanical pencil having all of the claimed features including a barrel (constituted by main body 20 and mouthpiece 32), a lead feeding mechanism (note lines 44-48 in col. 3) disposed in the barrel to tighten and feed a lead 22, a single-piece (note lines 58-62 in col. 4) lead holder (constituted by lead-holding member 36 and slider 44, note Fig. 3) disposed between the lead feeding mechanism and a tip end of the barrel (note Fig. 1), the lead holder having a through hole 40 through which the lead 22 passes (note Fig. 2) and having holding portions 52 for holding the lead 22 and a contact portion for contacting an inner peripheral face of the barrel (note Fig. 1), the holding portions 52 including a first holding portion 52 at a front portion of the lead holder and a second holding portion 52 at a rear portion of the lead holder (note Fig. 3) so that when a length of the lead 22 $a$  becomes shorter than a distance between the lead feeding mechanism and the tip end of the barrel, the first holding portion 52 holds the short lead 22 $a$  and the second holding portion 52 holds a next lead 22 $b$  (note lines 5-9 in col. 1 and Figs. 4 and 5) tightened by the lead feeding mechanism (note lines 13-22 in col. 7) especially when the lead 22 $a$  is so short so as to not completely occupy the lead holder and the next lead 22 $b$  is to be smoothly advanced to continue the writing operation, and wherein the contact portion of the lead holder is an outer peripheral surface 56 that is elastically displaceable (by the inherent elastic material of the lead holding member and the frictional resistance differences, note lines 45-53 in col. 1, lines 40-52 in col. 2,

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lines 29-53 in col. 5 and lines 1-5 in col. 4) radially outwardly into contact with the inner peripheral face of the barrel (note Fig. 6B and lines 23-29 in col. 7). With regard to claims 4 and 13, Kanari et al. further discloses that the lead holder has a body 36 (note Fig. 3), the contact portion has an outside cylinder 50 provided concentrically on an outside of the body, and the outside cylinder 50 has a rib 44 (note Fig. 3) projecting in an outside diameter direction to come into contact with an inner peripheral face of the barrel 20, 32. With regard to claims 5 and 14, Kanari et al. additionally disclose that the outside cylinder 50 has a slit 78 (note Fig. 8A) formed in a portion of the outside cylinder in which the rib 44 of the outside cylinder is absent. With respect to claims 6 and 15, Kanari et al. also disclose that the lead holder has a body 36 (note Fig. 3) and that one of the holding portions 52 has at least one blade 74 (note Fig. 8A and lines 58-62 in col. 4) projecting in an inside diameter direction in a front end part of the body to come into contact with the lead 22. With respect to claims 7 and 16, Kanari et al. further disclose that the lead holder has a body 36 (note Fig. 3) and that one of the holding portions 52 has a rib constituted by the lead holding portion 52 (note Fig. 3) projecting in an inside diameter direction in a rear end part of the body to come into contact with the lead 22. With regard to claims 8 and 17, Kanari et al. additionally disclose a slit 78 (note Fig. 8A) formed in a portion in which the rib is absent at the rear end part of the body. With respect to claim 19, Kanari et al. additionally disclose that the holding portions can constitute a blade 74 and a rib 52 in the case when the lead holder is formed integrally with the slider/outside cylinder 50,44 (note Figs. 3 and 8A, and lines 58-62 in col. 4). With respect to claim 20, Kanari et al. also disclose that one of the lead holding portions is forwardly positioned and another one of the lead holding portions is rearwardly positioned (note Fig. 3). With respect to claim 21, Kanari et al. also disclose a tip end of the

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barrel (note Fig. 2), a single-piece (note lines 58-62 in col. 4) writing medium holder (constituted by lead-holding member 36 and slider 44, note Fig. 3) held by the tip end of the barrel and having a through hole 40 through which a writing medium 22 protrudes, the writing medium holder having holding portions 52 for holding the writing medium 22, the holding portions 52 being formed at two (note Fig. 3) or more (note lines 53-55 in col. 4) positions along an axial length of the writing medium holder, the holding portions including a first holding portion 52 at a front portion of the holder and a second holding portion 52 at a rear portion of the holder (note Fig. 3), and an outer peripheral surface 56 that is elastically displaceable (by the inherent elastic material of the lead holding member and the frictional resistance differences, note lines 45-53 in col. 1, lines 40-52 in col. 2, lines 29-53 in col. 5 and lines 1-5 in col. 4) radially outwardly into contact with the inner peripheral face of the barrel (note Fig. 6B and lines 23-29 in col. 7), wherein when a length of the writing medium 22a becomes short, the first holding portion 52 holds the short writing medium 22a and the second holding portion 52 holds a next unused writing medium 22b (note lines 5-9 in col. 1 and Figs. 4 and 5) especially when the writing medium 22a is so short so as to not completely occupy the lead holder and the next writing medium 22b is to be smoothly advanced to continue the writing operation.

### ***Response to Arguments***

13. Applicants' arguments filed October 15, 2003 (Paper No. 8) have been fully considered but they are not deemed persuasive.

14. Applicants' argument that the Kanari et al. reference fails to teach or suggest certain features of applicant's invention has been carefully considered. However, as clearly noted in the



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above rejection of the claims, both the single-piece construction of the lead holder and the outer peripheral surface that is elastically displaceable radially outwardly into contact with the inner peripheral surface of the barrel are indeed disclosed by the reference.

15. In response to applicants' argument that the Kanari et al. reference fails to show certain features of applicants' invention, it is noted that the features upon which applicants rely (i.e., the holder fixing the lead relative to the barrel during writing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

16. Applicants' argument that the Kanari et al. reference does not fix the lead relative to the barrel during writing has been carefully considered. However, the reference does indeed disclose such a relationship (note Fig. 4 which clearly shows the holding portions fixing the lead 22 during writing).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen J. Prunner whose telephone number is 703-306-9044.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kathleen J. Prunner

March 3, 2004

A handwritten signature in black ink, appearing to read 'Gregory L. Huson', is written over a large, faint, stylized watermark that resembles the letters 'P' and 'S'.

GREGORY L. HUSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700